

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed June 28, 2005. At the time of the Office Action, Claims 1-13 were pending in this Application. Claims 1-13 were rejected. Claim 1 has been amended to further define various features of Applicants' invention. Claim 5 has been amended to correct a typographical error. Claims 14-20 have been added. Claims 1-20 are now pending in this Application. Applicants respectfully request reconsideration and favorable action in this case.

Objections under 37 CFR 1.83(a)

Examiner has objected to the drawings for not showing every feature of the invention specified in the Claims under 37 CFR 1.83(a). Figures 5A-B have been added to more clearly show the features claimed in Claims 9 and 10. The specification has been amended to describe Figures 5A-B according to page 3, line 27 through page 4, line 2, which describes the embodiments shown in Figures 5A-B. No new matter has been introduced.

Rejections under 35 U.S.C. § 112

Claim 5 was rejected by the Examiner under 35 U.S.C. §112, second paragraph, due to insufficient antecedent basis. Applicants amend Claim 5 as suggested by the Examiner to overcome this rejection.

Rejections under 35 U.S.C. § 102

Claims 1, 2, 4, and 9-12 were rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,467,702 issued to Malcolm David Dick-Lambert et al. ("Lambert et al."). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention as amended.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1997). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9

USPQ2d 1913, 1920 (Fed. Cir. 1989). Applicants respectfully submit that the cited art as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the amended claims.

Amended Claim 1 includes the limitation that “each injection orifice has a respective groove-shaped recess in the cone of the valve needle.” Lambert et al. does not teach a similar structure. Anything that could be considered a groove in Lambert et al. is shown either away from the valve needle entirely or as a part of the valve needle tip that is not the cone. For example, the annular groove in guide member 24 shown in Figure 2 is located away from the valve needle. Lambert et al. states that “guide member 24 is rigidly secured within the bore 11.” Column 6, lines 52-53. Thus, guide member 24 is actually stationary and not a part of the moving valve needle. Figure 4 of Lambert et al. is an example in which the valve needle region 12b that contains the annular grooves taught by Lambert et al. may be part of the valve needle tip, but not a part of the cone. Because Lambert et al. does not show equivalent recesses in the cone of the valve needle, Applicants believe Claim 1 is allowable as amended.

Claims 2, 4 and 9-12 are dependent on Claim 1 and are believed to be allowable as depending from an allowable base claim, and also as containing independently patentable features. Applicants respectfully request the withdrawal of the rejection of Claims 1, 2, 4 and 9-12.

Rejections under 35 U.S.C. §103

Claims 3 and 13 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lambert et al. in view of U.S. Patent 6,811,105 issued to Masaaki Kato et al. (“Kato et al.”). Claims 5-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lambert et al. in view of U.S. Patent 6,199,539 issued to Samuel Pearlman et al. (“Pearlman et al.”). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, do not render the claimed embodiment of the invention obvious as amended.

Claims 3, 5-8 and 13 are dependent on Claim 1 and are believed to be allowable as depending from an allowable base claim, and also as containing independently patentable features. As discussed above, Lambert et al. does not teach recesses in the cone of the needle

tip, and none of the art cited is believed to show this feature. Applicants respectfully request the withdrawal of the rejection of Claims 3, 5-8 and 13.

Added Claims

Claims 14-20 have been added. Independent Claim 14 is similar to the original version of Claim 1, but additionally includes the limitation of "each recess corresponding to one injection orifice." None of the art cited by the Office Action is believed to teach this element. Independent Claim 18 contains the limitation that there are a plurality of orifices each having a respective one of a plurality of recesses. None of the art cited by the Office Action is believed to teach this element.

Claims 15-17 and 19-20 are believed allowable as depending on allowable base claims, and also as containing independently patentable features. Applicants respectfully request allowance of new Claims 14-20.

Change of Correspondence Address

Applicants respectfully request that all papers pertaining to the above-captioned patent application be directed to Customer No. **31625** and all telephone calls should be directed to Andreas H. Grubert at 512.322.2545.

CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the claims as amended.

Applicants believe there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.322.2545.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorney for Applicants



Andreas Grubert
Limited Recognition No. L0225
Limited Recognition Under 37 C.F.R. §11.9(b)

Date: September 22, 2005

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PATENT APPLICATION
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APPENDIX

DRAWING AMENDMENTS

The drawings were objected to for failing to show every feature of the invention as specified in the claims. Please add drawing sheet 3 provided herewith showing new FIGURES 5A and 5B. Applicants certify the new figures contain no new matter and are supported by the specification.